



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/581,253 | 06/26/2000 | HIROO IKEGAMI | P107153-0000 | 5157 |

23353 7590 09/16/2004

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

MADSEN, ROBERT A

ART UNIT PAPER NUMBER

1761

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|-------------------------------|--------------------------------|--|
| Advisory Action | Application No. 09/581,253 | Applicant(s) IKEGAMI ET AL. | |
| | Examiner Robert Madsen | Art Unit 1761 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attached office action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1,2,6,10,12-14 and 16.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Declaration under 37 CFR 1.132 filed July 22, 2004 is insufficient to overcome the rejection of the claims as set forth in the last Office action because:
2. It includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. The declaration is directed to the primary reference only. The pending claims, however, are rejected on a combination of references. As set forth in the Office Action mailed April 22, 2004, Leftault Jr. et al. teach an aluminum or steel can for non-carbonated beverages at a pressure of from 1 to 50 psig (i.e. 0.07 to 3.5 kgf/sqcm), and differ from the claims only in teaching a particular annular bead height, a particular radius of the annular ground portion diameter, the thickness of the bottom wall, or a low acid beverage. As presented previously, Lyu teaches how to improve the strength of cans such as Leftault Jr.: the annular ground portion diameter is 85-95% of the outside can diameter to maintain rigidity and the height of the bead from the flat bottom is 0-10 times the thickness of the material used and that this height is an important factor to make the container more pressure resistant. MacPherson is relied on as evidence that the thickness of aluminum and steel used to make the conventional cans such as the one taught by Leftault Jr. et al. are the same as those recited in the claims (i.e. the bottom thickness of a steel can is 0.15 mm-0.22 mm and an aluminum

can is 25-0.35mm). With respect to the particular type of beverage placed into the can of Leftault et al., Jonas et al. teach low acid food container must be able to withstand up to 20 psi and must be able to be heat sterilized, like the one taught by Leftault, and Yamamoto et al. teach an aluminum or steel cans comprising an internal pressure of 0.6-1.8 kgf/sqcm , resistant to deformation, that undergo retorting after filling and sealing for *low acid* drinks. The resulting modified can of Leftault Jr. et al. meets the structural limitations set forth in the claims for the reason cited in the Office Action mailed April 22, 2004. Lyu teaches how to improve the strength of cans such as Leftault Jr.: the annular ground portion diameter is 85-95% of the outside can diameter to maintain rigidity and the height of the bead from the flat bottom is 0-10 times the thickness of the material used and that this height is an important factor to make the container more pressure resistant . MacPherson is relied on as evidence that the thickness of aluminum and steel used to make the conventional cans such as the one taught by Leftault Jr. et al. are the same as those recited in the claims (i.e. the bottom thickness of a steel can is 0.15 mm-0.22 mm and an aluminum can is 25-0.35mm).

3. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

4. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

5. Applicant's arguments filed July 22, 2004 have been fully considered but they are not persuasive.

6. Applicant argues that the a "feature" of claim 1 was not considered: "a low positive pressure canned food having an internal pressure aptitude. First, this feature, or limitation, appears in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. Additionally, the functional language appearing in the body of claim 1 "so as to have an internal pressure inspection aptitude for detecting internal pressure by measuring a vibration frequency of the bottom wall generated by striking a vicinity of a central portion of the bottom wall by an electromagnetic pulse" amounts to no more than an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

Art Unit: 1761

compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

8. In the present case, the testing aptitude depends on the structural design of the can. As discussed in the rejection of claim 1 and 6 in the Office Action of July 22, 2004, modification Leftault Jr. to enhance the strength of the can of Leftault Jr. includes the recited a annular bead height and an annular ground portion diameter (as taught by Lyu), and the particular material thickness is apparently a conventional aluminum or steel can thickness for pressurized foods (i.e. Leftault Jr. teaches pressurized food containers made from aluminum or steel). Thus, the structural limitations are met and modified Leftault Jr. et al. meet the intended use limitation, albeit not for the same intended purpose as applicant.

9. With respect to applicant's statement that the prior art fails to teach a negative pressure can has a high rigidity with a sidewall greater in thickness and thus is more expensive than that of conventional positive pressure cans, it is noted that these features upon which applicant relies (e.g. not having a thicker sidewall or high cost) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. With respect to applicant's assertion that the conventional positive can wall thickness lacks an internal pressure inspection aptitude to detect small leaks or has thickness to prevent buckling, applicant's attention is directed to MacPherson.

MacPherson teaches the conventional thickness of material used for pressurized cans:

Art Unit: 1761

steel 0.006-0.009 in (i.e. 0.15 mm-0.22 mm) and aluminum 0.010-0.014 in (i.e. 0.25-0.35mm) (Abstract, Column 3, lines 10-20). It is noted that Leftault Jr. et al. teach a pressurized aluminum or steel seamless can. Thus, as addressed in the Office Action mailed April 22, 2004, selecting such a thickness for the can walls and bottom would have been obvious.

11. With respect to applicant's statement that prior art teaches a dome-shaped bottom., it is noted that Leftault Jr. et al. do not teach a dome-shaped bottom.

12. In response to applicant's argument that there is no suggestion to combine the references as applied to independent claims 10, 12-14, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Leftault Jr. et al. teach an aluminum or steel can for non-carbonated beverages at a pressure of from 1 to 50 psig (i.e. 0.07 to 3.5 kgf/sqcm), and differ from the claims only in teaching a particular annular bead height, a particular radius of the annular ground portion diameter, the thickness of the bottom wall, or a low acid beverage. Lyu teaches how to improve the strength of pressurized aluminum and steel cans such as Leftault Jr.: the annular ground portion diameter is 85-95% of the outside can diameter to maintain rigidity and the height of the bead from the flat bottom is 0-10 times the thickness of the material used and that this height is an important

factor to make the container more pressure resistant . Thus, from a structural integrity standpoint, Lyu provides motivation to modify Leftault Jr. as recited. Also, MacPherson teaches the thickness of aluminum and steel used to make the conventional cans such as the one taught by Leftault Jr. et al. are the same as those recited in the claims (i.e. the bottom thickness of a steel can is 0.15 mm-0.22 mm and an aluminum can is 25-0.35mm).

13. Regarding applicant's assertion that the prior art does not recognize the problem identified by applicant for the limitations of claims 10,12-14, the prior art does recognize the recited features not taught by Leftault Jr. (i.e. the bead height, the diameter of ground portion, and the material thickness) are desirable to strengthen a pressurized can and, in the case of the material thickness, considered conventional. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

14. With respect to the rejection of claim 16, applicant asserts that the examiner did not address the claimed temperature limitation. This argument is moot since there is no temperature limitation in the copy of the claims filed April 30, 2003. The claim recites "degrees", but that is in terms of an angle of inclination, not a temperature.

15. Also regarding claim 16, applicant asserts that the examiner has failed to address the various ranges of dimensions recited in the claim. However, applicant's attention is directed to Pages 13-18 in the Office Action mailed April 22, 2004, where

Art Unit: 1761

the examiner addresses, at great length, the limitations recited in claim 16. Applicant further argues that the examiner has merely pointed out features in various references. The examiner has discussed at great length what the primary reference teaches and what the various references teaches, why they are relevant to the teaching of the primary reference, and why one of ordinary skill in the art would have been motivated to modify the primary reference in view of the various references. Overall, Applicant's arguments with respect to claim 16 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1761

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen
Examiner
Art Unit 1761



MILTON I. CANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700